

REMARKS

The present application was originally filed with 20 claims. The Examiner rejected claims 1-20. Applicant respectfully requests that the Examiner consider the current rejection of the claims in light of the amendments presented herein and the following remarks. For the Examiner's convenience, Applicant will address the rejections in the order in which they appear in the Office Action.

The Examiner rejected claims 8, 12, and 15 under 35 U.S.C. §112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has cancelled claim 8 without prejudice to presentation of this claim in this or a later filed case. Accordingly, the rejection of claim 8 under 35 U.S.C. §112, second paragraph, is now moot.

With respect to claim 12, the Examiner has indicated that is unclear as to what type of percentage the "about 25 to 65%" refers to in the claim. Applicant has amended claim 12 to include that percentage refers to the total solids content of the aqueous pigment dispersion is "between about 25 to 65 weight percent of said aqueous pigment dispersion." Accordingly, in light of this amendment to claim 12, Applicant respectfully requests that this rejection be withdraw.

Regarding the rejection of claim 15, Applicant has cancelled claim 15 without prejudice to presentation of this claim in this or a later filed case. Accordingly, the rejection of claim 15 under 35 U.S.C. §112, second paragraph, is now moot.

The Examiner rejected claims 1-4 and 6-8 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,571,588 issued to Lussi et al. ("the Lussi patent"). The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The Lussi patent does not describe each and every element as set forth in amended independent claim 1 and Applicant traverses this rejection. For example, the Lussi patent fails to disclose unconsolidated surface material that includes loose rubber particles each having a color coating and a polymer coating. Rather, the Lussi patent discloses an inlaid

floor covering that is essentially a sheet vinyl flooring product. Accordingly, since the inlaid floor covering is not unconsolidated surface material, Applicant respectfully requests that the rejection to independent claim 1 and the claims that depend therefrom (i.e., 2-7) be withdrawn.

The Examiner rejected claims 5 and 9-20 under 35 U.S.C. §103(a) as being unpatentable over the Lussi patent in view of U.S. Patent No. 5,714,263 to Jakubisin ("the Jakubisin patent"). The Examiner is reminded that three basic criteria must be met to establish a *prima facie* case of obviousness. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success to modify the reference or to combine reference teachings.

Applicant respectfully asserts that claims 9-14 and 16-17 include at least one limitation not taught or suggested by the combination of the Lussi and Jakubisin patents ("the Lussi/Jakubisin combination"). For example, the method recited in independent claim 9 includes separate steps of "mixing vulcanized rubber particles with an aqueous pigment dispersion ... thereby forming color coated rubber particles" and "adding an emulsion polymer to the color coated rubber particles to form a protective film around the color coated rubber particles," which are not disclosed by or suggested in the Lussi/Jakubisin combination.

Regarding the cited references, the Lussi patent is silent with respect to the type of colorant and the method used to color the spheroidal particles. Further, the Lussi patent fails to teach or suggest a separate step of adding a polymer to the color coated rubber particles to form a protective film around the color coated rubber particles. The Jakubisin patent discloses the formation of a decorative and protective film around rubber fragments by spraying a liquid coating material (containing modified acrylic copolymer resin, color pigment, and rheological additives) directly onto the rubber fragments. However, since the color pigment and the modified acrylic copolymer resin are applied to the rubber fragments in a one-step process, the Jakubisin patent does not disclose or suggest separate steps of "mixing

vulcanized rubber particles with an aqueous pigment dispersion ... thereby forming color coated rubber particles” and “adding an emulsion polymer to the color coated rubber particles to form a protective film around the color coated rubber particles.”

Since the Lussi/Jakubisin combination fails to teach or suggest the separate steps of “mixing vulcanized rubber particles with an aqueous pigment dispersion ... thereby forming color coated rubber particles” and “adding an emulsion polymer to the color coated rubber particles to form a protective film around the color coated rubber particles,” it is respectfully submitted that a *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests that the rejection to independent claim 9 and the claims that depend therefrom (i.e., 10-14, 16-17) be withdrawn and these claims be passed to issue. To the extent that the Examiner disagrees with Applicant, Applicant respectfully requests that the Examiner specifically cite the column number and line number(s) of either reference that teaches the application of an aqueous pigment dispersion and a polymer coating in separate steps as recited in independent claim 9.

Furthermore, Applicant respectfully asserts that claims 18-20 include at least one limitation not taught or suggested by the Lussi/Jakubisin combination. For example, the Lussi/Jakubisin combination fails to teach or suggest the separate steps of “mixing rubber particles with an aqueous pigment dispersion ... thereby forming color coated rubber particles” and “mixing an aqueous polymer dispersion with the color coated rubber particles to encapsulate the color coated rubber particles ...” recited in independent claim 18 for the reasons described above. Since the Lussi/Jakubisin combination fails to teach or suggest the application of an aqueous pigment dispersion and an aqueous polymer dispersion in separate steps, it is respectfully submitted that a *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests that the rejection to independent claim 18 and the claims that depend therefrom (i.e., 19-20) be withdrawn and these claims be passed to issue.

In view of the remarks presented above, it is believed that pending claims 1-7, 9-14, and 16-20 are in condition for allowance and notice to such effect is respectfully requested. If

the Examiner thinks a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned at the number provided below.

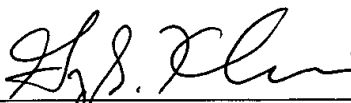
Furthermore, Applicant's attorney requests that the Examiner fully consider the references submitted with the Supplemental Information Disclosure Statement ("IDS") and Form PTO/SB/08A provided herewith and initial the Form PTO/SB/08A where indicated.

The Commissioner is authorized to charge Deposit Account 02-2051, identifying Docket No. 26200-11, for any fees that may be due in connection with this Amendment and Response.

Respectfully submitted,

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